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Remarks:

Reconsideration of the application is requested.

Claims 1 to 40 remain in the application. Claims 1 to 24 and 33 to 40 are subject to examination and claims 25 to 32 have been withdrawn from examination. Claims 15 to 24 and 33 to 40 are allowed over the prior art. Claims 5 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1, 4, and 10 have been amended.

In item 3 on pages 2 to 3 of the above-identified Office action, claims 1 to 4, 6 to 11, 13 and 14 been rejected as being fully anticipated by U.S. 5,049,153 to Nakao et al. (hereinafter "Nakao") under 35 U.S.C. § 102.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. Support for the changes is found in FIGS. 4 to 9, for example, of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

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Claim 1 calls for, *inter alia*, a surgical clip applier for applying a surgical clip having two clip arms each with a longitudinal length and a substantially rectangular cross-section, the clip applier comprising:

- a) a hollow member having a proximal end and a distal end;
- b) a clevis coupled to the distal end of the hollow member;
- c) a first jaw rotatably coupled to the clevis;
- d) a second jaw rotatably coupled to the clevis in opposed relation to the first jaw, the first and second jaws having a respective longitudinal extent, at least one of the first and second jaws defining a clip-sliding channel:

extending substantially along the longitudinal extent;

having a rectangular cross-section substantially corresponding to the cross-section of one surgical clip arm;

having a longitudinal length greater than the longitudinal length of the one arm to define a clip-holding portion and a clip-sliding portion; and

slidably guiding the surgical clip longitudinally along the clip-sliding portion when the first and second jaws apply the surgical clip to tissue disposed therebetween.

Claim 10 calls for, *inter alia*, a similar surgical clip applier, including:

- c) a first jaw rotatably coupled to the clevis, the first jaw having a longitudinal extent and a first clip-sliding channel disposed substantially along the longitudinal extent and terminating in a first anvil;

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d) a second jaw rotatably coupled to the clevis in opposed relation to the first jaw, the second jaw having a longitudinal extent and a second clip-sliding channel disposed substantially along the longitudinal extent and terminating in a second anvil, each of the first and second clip-sliding channels:

having a rectangular cross-section substantially corresponding to the cross-section of one of the surgical clip arms;

a longitudinal length greater than the longitudinal length of the respective arm to define a clip-holding portion and a clip-sliding portion; and

slidably guiding the surgical clip longitudinally along the clip-sliding portion when the first and second jaws apply the surgical clip to tissue disposed therebetween.

In the rejection, the Examiner has applied only the Nakao configuration shown in FIGS. 16 to 19 and as described at col. 9, line 53, to col. 10, line 60. These figures and the corresponding specification clearly provide that the two jaws "158 and 160 are formed on inwardly facing surfaces with respective longitudinal grooves 166 and 168 **in which** legs 170 and 172 of a staple 174 are seated." Nakao at col. 10, lines 13 to 15 (emphasis added). See also *id.* at line 21 ("seating in grooves 166 and 168.").

In order to keep the staple 174 within the jaws 158, 160 of the Nakao device, the staple 174 must be stationary, i.e., "seated." For if the staple 174 moved in the grooves 166, 168, then it would have the chance of falling out of the interior chamber of

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the jaws 158, 160 - a situation that is entirely unacceptable to Nakao. As can be clearly seen in FIGS. 16 to 18, the top leg 170 of the staple 174 extends completely from the inner left-most end of the mouth of the jaws to the inner right-most end of the mouth of the jaws (at the curve defined by the Examiner in the rejection on page 3 as the "hook shaped anvil"). Such position holds the staple 174 in the jaws 158, 160 for use and Nakao does not suggest anything other than *snugly* seating the staple 174 in the jaws 158, 160. Accordingly, the staple 174 **cannot slide in any way with respect to the jaws 158, 160 and remains longitudinally fixed with respect to the jaws 158, 160.**

In complete contrast, claims 1 and 10 provide that at least one of the jaws of the invention of the instant application slidably apply the surgical clip. Such application occurs because of the presence of a clip-sliding channel - a feature that is not present on or even suggested by Nakao. This clip-sliding channel has distinct features (each of which is not present in Nakao):

- 1) It has a rectangular cross-section substantially corresponding to the cross-section of a surgical clip arm loaded therein;

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2) It has a longitudinal length greater than the longitudinal length of the arm seated therein to define a portion where the clip arm is held and a portion over which the clip arm slides; and

3) It slidably guides the surgical clip longitudinally along the clip-sliding portion when the first and second jaws apply the surgical clip to tissue disposed therebetween.

Because the Nakao device cannot "slidably apply" the surgical clip, e.g., the staple 174, and due to the fact that Nakao only discloses a tight fit of the staple 174 within the jaws, Nakao cannot be said to anticipate the invention as set forth in amended claims 1 or 10 of the instant application.

Based upon the above, claims 1 and 10 are believed to be allowable. Insofar as claims 2 to 9 and 11 to 14 are ultimately dependent upon claims 1 or 10, it is respectfully believed that these claims are allowable as well. Thus, the objection of claims 5 and 12 is believed to be moot.

In view of the foregoing, reconsideration and allowance of claims 1 to 24 and 33 to 40 are solicited.

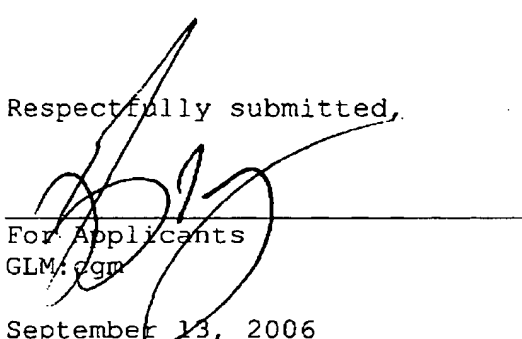
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In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Gregory L. Mayback, P.A., No. 503,836.

Respectfully submitted,

  
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For Applicants  
GLM:ggm

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